

REMARKS

The applicants note with appreciation the acknowledgement of the claim for priority under section 119 and the notice that all of the certified copies of the priority documents have been received.

The applicants acknowledge and appreciate receiving a copy of form PTO-1449, on which the examiner has initialed all listed items.

Claims 1 – 19 are pending. Claims 14 – 19 have been withdrawn. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

On page 4 of the office action, dependent claims 4 – 6 were objected to, but indicated as being allowable if rewritten in independent form. Claim 4 has been rewritten in independent form to include claim 1, and it is respectfully submitted that claims 4 – 6 as rewritten are allowable.

The applicants have rewritten the claims in independent form since the office action indicated that claims 4 – 6 would be allowable if so re-written. However, the applicants do not concede that other features in the claims are found in the prior art.

The applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, the applicants reserve the right to pursue the original subject matter in a continuation application.

Any narrowing amendment to the claims in the present Amendment is not to be construed as a surrender of any subject matter between the original claims and the present claims; rather this is merely an attempt at providing one or more definitions of what the applicants believe to be

suitable patent protection. In addition, the present claims provide the intended scope of protection that the applicants are seeking for this application. Therefore, no estoppel should be presumed, and the applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

For all the reasons advanced above, the applicants respectfully submit that the claims as amended are allowable.

Claim 13 has been amended to correct a cosmetic defect.

Claims 1 – 3, 12 and 13 were rejected under 35 USC 102(e) as being unpatentable over U.S. Patent 6,710,484, Kitoh et al. (“Kitoh”). Also, claims 7 – 10 were rejected under 35 USC 103(a) as being unpatentable over Kitoh in view of U.S. Patent 6,107,713, Hulsmann et al. (“Hulsmann”). The rejection is respectfully traversed for reasons including the following, which are provided by way of example.

As described in the application, the invention is directed to solving disadvantages such as caused by stress applied to a control circuit board. (Specification 4, lines 1 – 7.)

According to the claims, e.g., claim 1, the invention is directed to a motor. A motor main body includes a rotatable shaft, which is rotated upon energization of the motor main body. A gear housing is joined to the motor main body and receives an output shaft and a speed reducing mechanism, wherein the speed reducing mechanism reduces a rotational speed of the rotatable shaft and conducts the reduced rotational speed of the rotatable shaft to the output shaft. The gear housing has a main body side connector, from which electric power is supplied to the motor main body. A control device controls the motor main body and includes a control circuit board and a circuit board receiving case. The control circuit board is received in the circuit board receiving case without being directly joined to the circuit board receiving case and has a circuit

board side connector. The circuit board side connector is installed to the main body side connector in a first direction to supply electric power to the motor main body through the main body side connector. The circuit board receiving case includes a gear housing side opening that is installed to the gear housing in the first direction to receive the control circuit board in the circuit board receiving case. A fixing means releasably fixes the control circuit board to the gear housing to prevent movement of the control circuit board relative to the gear housing in a second direction, which is opposite from the first direction. (E.g., claim 1.) Thereby, replacement of the control circuit board can be eased. (E.g., specification p. 18 lines 10-11.)

The office action asserts that Kitoh discloses the invention as claimed. To the contrary, Kitoh fails to teach or suggest the invention, as presently claimed, when the claims are considered as a whole. Kitoh fails to teach or suggest, for example, that “the control circuit board is received in the circuit board receiving case without being directly joined to the circuit board receiving case and has a circuit board side connector.” (See claim 1.) Moreover, Kitoh fails to teach or suggest, for example, that “the circuit board receiving case includes a gear housing side opening that is installed to the gear housing in the first direction to receive the control circuit board in the circuit board receiving case.” (See claim 1.) This clearly indicates that the circuit board receiving case, which receives the control circuit board, is formed separately from the gear housing and is installed to the gear housing through the gear housing side opening.

According to Kitoh, e.g., Fig. 2, in contrast, the control circuit board (31a) is directly received in the ECU receiving portion (21e) of the gear housing (21) (e.g., Col. 6, lines 22-33). Consequently, Kitoh fails to teach or suggest the above-mentioned elements which are recited in independent claim 1. Kitoh fails to teach or suggest the circuit board receiving case as claimed,

which is formed separately from the gear housing. It is respectfully submitted therefore that claim 1 is patentable over Kitoh.

In addition, it is respectfully submitted that the office action presents an impermissible omnibus rejection of claim 1. It appears that the only element of claim 1 that the examiner located in Kitoh is the recited fixing means, although the office action states that "Kitoh et al. shows all of the limitations of the claimed invention." Accordingly, it appears that a proper rejection under 35 USC 102 has not been made. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The applicants' comments herein are therefore directed to the rejection as best understood by applicants.

For at least these reasons, the combination of features recited in independent claim 1, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Kitoh clearly fails to show other claimed features as well.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claim 1, but also because of additional features they recite in combination.

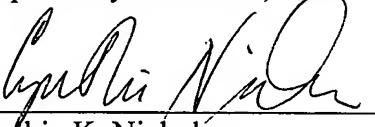
The applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited prior art shown any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the forgoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



Cynthia K. Nicholson
Reg. No. 36,880

Posz & Bethards, PLC
11250 Roger Bacon Drive, Suite 10
Reston, VA 20190
Phone 703-707-9110
Fax 703-707-9112
Customer No. 23400